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<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Postcard Remarks
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Law Offices of Patrick J.S. Inouye		
Signature			
Printed name	Patrick J.S. Inouye		
Date	September 12, 2006	Reg. No.	40297

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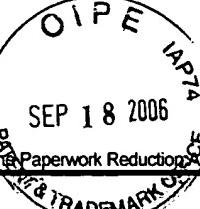
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Signature			
Typed or printed name	Lali Liparteliani	Date	September 12, 2006

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SEP 18 2006

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2006

 Applicant Claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 500.00)

Complete if Known

Application Number	09/717,278
Filing Date	November 22, 2000
First Named Inventor	Wang Baldonado
Examiner Name	Victor D. Lesniewski

Art Unit 2152

Attorney Docket No. A0834

METHOD OF PAYMENT (check all that apply)

 Check Credit Card Money Order None Other (please identify): _____

 Deposit Account Deposit Account Number: 24-0037 Deposit Account Name Xerox Corporation

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

 Charge fee(s) indicated below Charges fee(s) indicated below, except for the filing fee

 Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Small Entity

Fee (\$) 50

Fee (\$) 25

Each independent claim over 3 (including Reissues)

Fee (\$) 200

Fee (\$) 100

Multiple dependent claims

Fee (\$) 360

Fee (\$) 180

Total Claims

Extra Claims

Fee (\$)

Fee Paid (\$)

$$- 20 \text{ or HP} = 0 \times \$50.00 = \$ 0.00$$

Multiple Dependent Claims

Fee (\$)

Fee Paid (\$)

\$360.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims

Extra Claims

Fee (\$)

Fee Paid (\$)

$$- 3 \text{ or HP} = 0 \times \$200.00 = \$ 0.00$$

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41 (a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = 0 / 50 = 0 (round up to a whole number)	x \$250.00 =		\$ 0.00	\$ 0.00

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief Fee: \$500.00

\$500.00

SUBMITTED BY

Signature		Registration No. 40297 (Attorney/Agent)	Telephone (206) 381-3900
Name (Print/Type)	Patrick J. S. Inouye		Date September 12, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Wang Baldonado et al.) Group Art Unit: 2152
)
Serial No. 09/717,278) Examiner:
) Victor D. Lesniewski
Filed: November 22, 2000)
)
10 For: Systems And Methods For Performing)
Sender-Independent Managing Of)
Electronic Messages)

15

APPEAL BRIEF

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
20 Alexandria, VA 22313-1450

BRIEF ON BEHALF OF WANG BALDONADO ET AL.:

Appellant appeals from the final Office action mailed May 12, 2006, in which currently-pending claims 1-8, 10-14, and 16-25 stand rejected. Appellant filed a Notice of Appeal on July 12, 2006 by facsimile.

09/19/2006 MGE BREM1 00000026 240037 09717278

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TABLE OF CONTENTS

1.	REAL PARTY IN INTEREST	3
2.	RELATED APPEALS AND INTERFERENCES.....	3
3.	STATUS OF CLAIMS	3
5	4. STATUS OF AMENDMENTS	3
10	5. SUMMARY OF CLAIMED SUBJECT MATTER	3
	A. Independent Claim 1	3
	B. Independent Claim 7	4
	C. Independent Claim 13	4
15	D. Independent Claim 19	5
20	6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL	6
	7. ARGUMENT	6
	A. U.K. Patent Application No. GB 2,324,627 (“Pan”)	6
	B. Legal Basis	7
15	C. Claims 1-6 and 21 (Group I)	7
	D. Claims 7-8, 10-12, 22, and 24 (Group II)	10
	E. Claims 13-14, 16-18, 23, and 25 (Group III)	13
	F. Claims 19 and 20 (Group IV).....	17
20	8. CLAIMS APPENDIX.....	21
	9. EVIDENCE APPENDIX	27
	10. RELATED PROCEEDINGS APPENDIX	28

1. REAL PARTY IN INTEREST

The real party in interest is assignee Xerox Corporation, a New York Corporation, located at 800 Long Ridge Road, P.O. Box 1600, Stamford, Connecticut 06904-1600.

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2. RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed on July 12, 2006. There are no other appeals or interferences known to Appellant, Appellant's legal counsel, or assignee, which will directly affect or be directly affected by or have a bearing on the 10 Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1-8, 10-14, and 16-25 are rejected and under appeal. An Appendix setting forth the Claims involved in the appeal is included as Section 8 of this 15 Appeal Brief.

4. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of Claims 1-8, 10-14, and 16-25. Claims 1-8, 10-14, and 16-25 are pending.

20

5. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

Claim 1 defines an electronic message management system device that includes a digest specification device, an information selection device and an 25 electronic message management device (p. 7, lines 14-18). A digest specification device allows a user to obtain multiple digests of multiple electronic messages obtained from the information stream based on a set of at least one sender-independent message-based rules implemented by the user (p. 8, lines 14-34). The digests consist of one or more electronic messages that satisfy the sender-

independent message-based rules for a particular digest (p. 5, lines 5-8). All sender-independent message-based rules must be met for a message to be included in a digest (p. 8, lines 19-20; p. 10, lines 1-3). An information selection device monitors the information stream and selects messages that comply with a 5 set of one or more sender-independent message-based rules for at least one of the plurality of digests (p. 8, lines 14-24). An electronic message management device determines which digest corresponds to the set of sender-independent message-based rules satisfied by the selected candidate message and integrates the selected message into the corresponding digest (p. 8, lines 21-29). The digest is 10 determined and updated based on one or more of the sender-independent message-based rules that specify characteristics of the digest (p. 8, line 31 through p. 9, line 5).

B. Independent Claim 7

Claim 7 defines a method for managing electronic messages including 15 obtaining a plurality of digests from an information system based on a set of sender-independent message-based rules (p. 8, lines 14-34). The digests consist of one or more electronic messages that satisfy the sender-independent message-based rules for a particular digest (p. 5, lines 5-8). The method includes monitoring an information stream and selecting messages that satisfy all the rules 20 in at least one set of sender-independent message-based rules (p. 8, lines 14-24). Next, the method includes determining which digest corresponds to the set of sender-independent message-based rules of the selected message and integrating the selected message into the corresponding digest (p. 8, lines 21-29). The method also includes determining and updating the digest based on one or more 25 of the sender-independent message-based rules that specify characteristics of the digest (p. 8, line 31 through p. 9, line 5).

C. Independent Claim 13

Claim 13 defines an information storage media that stores information to manage electronic messaging (p. 3, lines 25-28). The information storage media 30 comprises information that obtains a plurality of digests from an information

stream based on a set of sender-independent message-based rules specified by the user (p. 8, lines 14-34). The digests consist of one or more electronic messages that satisfy the sender-independent message-based rules for a particular digest (p. 5, lines 5-8). The storage media holds information that monitors the information stream and selects one or more electronic messages that satisfy at least one of the sets of sender-independent message-based rules (p. 8, lines 14-24). The information storage media includes information that determines which digest corresponds to the selected message and integrates the selected message into the correct digest (p. 8, lines 21-29). The storage media further includes information that determines and updates the digest based on one or more sets of sender-independent message-based rules (p. 8, line 31 through p. 9, line 5).

D. Independent Claim 19

Claim 19 defines an electronic message management system that includes a digest specification system, a data selection system and an electronic message management system (p. 7, lines 14-22). A digest specification system allows a user to obtain a plurality of digests from the information system based on a set of one or more sender-independent message-based rules specified by the user (p. 8, lines 14-34). The digests are made of one or more electronic messages that satisfy the sender-independent message-based rules (p. 5, lines 5-8). The data selection system monitors the information stream and selects messages that satisfy the set of rules for at least one of the plurality of digests (p. 8, lines 14-24). The electronic management system is functionally associated with the data selection system and determines which digest corresponds to the set of sender-independent message-based rules satisfied by the selected electronic message. The electronic management system is adapted to integrate the selected message into the corresponding digest (p. 8, lines 21-29). The electronic management system is further adapted to determine and update the digest based on one or more of the sender-independent message based rules that specify characteristics of the digest (p. 8, line 31 through p. 9, line 5).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-8, 10-14, and 16-25 were properly rejected under 35 U.S.C. § 102(b) as being anticipated by U.K. Patent Application No. GB 2,324,627, filed by Simoni and Pan (“Pan”).

5 7. ARGUMENT

A *prima facie* case of anticipation under 35 U.S.C. § 102(b) has not been shown and the rejection of Claims 1-8, 10-14, and 16-25 cannot stand.

A. U.K. Patent Application No. GB 2,324,627 (“Pan”)

Pan discloses a user interface to electronic news communications. The 10 user interface includes a client applet with the ability to communicate with a super server application, a Network News Transfer Protocol (“NNTP”) server application, a chat server application, and a mail server application (p. 17, lines 21-23). The super server application includes a database and request handler (p. 16, lines 14-22). The database stores and maintains newsgroups from news 15 servers and preferences of users (p. 16, lines 15-16). Newsgroups are an aggregation or collection of posted messages from users (p. 33, lines 6-7). Users are able to post articles, read and respond to articles posted by others, and participate in discussions, known as “threads” (p. 1, line 14-17). Users must have access to a news server and an NNTP server application to participate in the 20 newsgroups. The request handler processes client applet requests (p. 16, lines 17-22).

The client applet enables a user to retrieve the newsgroups and to send reply messages to the super server application for posting to the newsgroups (p. 17, lines 16-23). The client applet may be extended to provide flexible filtering of 25 undesired content (p. 27, lines 17-19). The client applet may also be extended to provide collaborative filtering based on whether a particular newsgroup article or thread of discussion was read by other users (p. 28, lines 6-8). As well, the client applet may be extended to provide a custom newsgroup created by applying filtering criteria across several newsgroups (p. 33, lines 1-2). Each custom

newsgroup is an aggregation of individual messages that meet a set of criteria specified by a user; however, a custom newsgroup is not a separate or distinct newsgroup created by NNTP servers (p. 33, lines 4-6). Custom newsgroups are best implemented within the super server application to prevent the client applet 5 from having to download a large set of articles from different newsgroups (p. 33, line 21-p. 34, line 2).

B. Legal Basis

A claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, 10 in a single prior art reference. *See, Crown Ops. Int'l., Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). If each and every element of a claim is not described in the reference, the claim has not been anticipated. Applicant traverses the rejection because a *prima facie* showing that each and every element is present in the reference, Pan, has not been established.

15 The rejected claims do not stand or fall together. The rejections of Claims 1-6 and 21 (Group I), Claims 7-12, 22, and 24 (Group II), Claims 13-14, 16-18, 23, and 25 (Group III), and Claims 19-20 (Group IV) are argued separately.

C. Claims 1-6 and 21 (Group I)

1. Group I Claims Should Be Argued Separately

20 Claims 1-6 and 21 warrant separate argument. Claim 1 defines an electronic message management system that recites specific structural limitations, such as, a digest specification device, an information selection device, and an electronic message management device (p. 7, lines 14-18). Analogous structural elements are not recited in the claims of Groups II, III, and IV. Moreover, the 25 steps recited in the claims of Group II are untied to specific structure. Similarly, the information recited in the elements of the claims of Group III is untied to specific structure. Finally, the systems recited in the elements of the claims of Group IV do not have like structural limitations. Accordingly, Claim 1 and Claims 2-6 and 21, dependent thereon, should be reviewed separately.

2. *Pan* Fails To Disclose Digests

Claim 1 recites a digest specification device that allows a user to obtain a plurality of *digests* from an *information stream* comprising a plurality of electronic messages (emphasis added). Claim 1 further recites, an information selection device that *monitors* the information stream and *selects* one or more of the plurality of candidate messages *in* the information stream (emphasis added). In contrast, Pan teaches a newsgroup that is an aggregation of posted messages from users that is stored in a database, and which meets a set of criteria specified by the user or the administrator of a super server application (*Pan*, p. 33, lines 6-7). Newsgroups are static content, unlike a plurality of messages selected from an information stream, per Claim 1. The news server is passive and accepts messages newly posted for users without monitoring or selecting, per Claim 1. Finally, custom newsgroups are not distinct newsgroups carried by news servers, but are constructed as an amalgamation of articles of newsgroups supplied and stored by news servers (*Pan*, p. 4, lines 9-10). Accordingly, digests obtained from an information steam, per Claim 1, are neither taught nor suggested by Pan.

3. *Pan* Fails to Disclose Sender-Independent Rules

Claim 1 recites one or more sender-independent message based rules that specify characteristics of the digest. In contrast, Pan teaches a set of filtering criteria to create custom newsgroups as an aggregation of messages selected from existing newsgroups stored by the super server in the database (*Pan*, p. 33, lines 1-7). Filtering criteria are set through the client applet to specify the newsgroups or part of an improved newsgroup hierarchy across which the filtering criteria is applied (*Pan*, p. 33, lines 7-9). The criteria, though, is dependent upon the originator of each message, which is either a newsgroup or newsgroup hierarchy (*Id.*). The filtering criteria can be set to include all newsgroups, but application of the criteria is still limited to messages stored in at least one of the newsgroups, whereas the sender-independent rules recited in Claim 1 apply to any message originating in an information stream, independent of originator. Accordingly,

sender-independent message-based rules, per Claim 1, are neither taught nor suggested by Pan.

4. *Pan Is Many-To-One*

Claim 1 recites obtaining a *plurality* of digests from an information stream comprising a *plurality* of candidate messages and further recites, an electronic message management device that determines, for each of the selected candidate messages, *which* of the plurality of digests corresponds to the set of sender-independent message-based rules (emphasis added). In contrast, Pan teaches that custom newsgroups are an aggregation of messages from other newsgroups or a newsgroup hierarchy that meet a set of criteria specified by the user or the administrator of super server application (*Pan*, p. 33, lines 1-7). Messages from one or more newsgroups are selected using the filtering criteria and are included in a single custom newsgroup (*Pan*, p. 33, lines 1-2). Consequently, Pan discloses forming a custom newsgroup in a many-to-one relationship, whereas Claim 1 defines a many-to-many relationship, such that a plurality messages from the information stream can be simultaneously assigned to any of the digests, independent of source (*Pan*, p. 33, lines 1-2). Accordingly, determining for each of the selected candidate messages, which of the plurality of digests corresponds, per Claim 1, is neither taught nor suggested by Pan.

5. *Pan Requires Messages From Newsgroups*

Claim 1 recites a digest specification device that obtains a plurality of digests *from an information stream* (emphasis added). In contrast, Pan teaches filtering criteria applied across several existing newsgroups to create a custom newsgroup (*Pan*, p. 33, lines 1-2). The user or the administrator of the super server application can specify the newsgroups across which the specified criteria are applied (*Pan*, p. 33, lines 7-9). The news articles are supplied by the news servers and are stored as static content (*Pan*, p. 4, lines 9-10). Thus, messages in a custom newsgroup originate first from a user, then are stored in a newsgroup, and finally are filtered against the criteria. Messages must then go through an intermediary newsgroup, rather than being obtained from an information stream,

per Claim 1 (*Id.*). Accordingly, Pan teaches away from an information selection device as recited in Claim 1.

6. *Prima Facie* Case of Anticipation Is Not Shown

- Accordingly, a *prima facie* case of anticipation under 35 U.S.C. §102(b)
- 5 has not been shown with respect to independent Claim 1. Claims 2-6 and 21 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Moreover, Claim 2 recites further comprising a digest management device that delivers the digest to a predetermined destination upon satisfaction of at least one set of sender-
- 10 independent message-based rules. Pan does not disclose a device that delivers newsgroups based on a set of sender-independent message-based rules. Rather, Pan teaches a Web-like interface to electronic news. The Web-like interface sorts newsgroups into logical categories (*Pan*, p. 5, line 12-13). A first screen of the user interface includes a series of icons and each icon corresponds to a particular category or grouping of network newsgroups (*Pan*, p. 19, lines 2-8 and Fig. 5). Sorting of newsgroups is different from digesting because digesting allows multiple electronic messages to be collected and sent as a single message (Spec., p. 4, line, 5-6). The user can specify when and how often the digest should be received (Spec., p. 6, line 6).
- 15 As a *prima facie* case of anticipation has not been established, withdrawal of the rejection of Claims 1-6, and 21 under 35 U.S.C. § 102(b) is respectfully requested.

D. **Claims 7-8, 10-12, 22, and 24 (Group II)**

1. Group II Claims Should Be Argued Separately
- 25 Claim 7 defines a method for managing electronic messages that recites obtaining a plurality of digests, monitoring the information stream, selecting one or more of the plurality of candidate messages, determining which of the plurality of digests corresponds to the set of sender-independent message-based rules, and determining and updating the digest based on one or more of the sender-

independent message-based rules. Specific steps are not recited in the claims of Groups I, III, and IV. Moreover, the devices recited in the elements of the claims of Group I are untied to specific steps. Similarly, the information recited in the elements of the claims of Group III is untied to specific steps. Finally, the 5 systems recited in the elements of the claims of Group IV are untied to specific steps. Accordingly, Claim 7 and Claims 8, 10-12, 22, and 24, dependent thereon, should be reviewed separately.

2. *Pan* Fails To Disclose Digests

Claim 7 recites obtaining a plurality of *digests* from an *information stream* comprising a plurality of electronic messages (emphasis added). Claim 7 further recites, *monitoring* the information stream and *selecting* one or more of the plurality of candidate messages *in* the information stream (emphasis added). In contrast, Pan teaches a newsgroup that is an aggregation of posted messages from users that is stored in a database, and which meets a set of criteria specified by the 15 user or the administrator of a super server application (*Pan*, p. 33, lines 6-7). Newsgroups are static content, unlike a plurality of messages selected from an information stream, per Claim 7. The news server is passive and accepts messages newly posted by users without monitoring or selecting, per Claim 7. Finally, custom newsgroups are not distinct newsgroups carried by news servers, 20 but are constructed as an amalgamation of articles of newsgroups supplied and stored by news servers (*Pan*, p. 4, lines 9-10). Accordingly, digests obtained from an information stream, per Claim 7, are neither taught nor suggested by Pan.

3. *Pan* Fails To Disclose Sender-Independent Rules

Claim 7 recites one or more sender-independent message-based rules that 25 specify characteristics of the digest. In contrast, Pan teaches a set of filtering criteria to create custom newsgroups as an aggregation of messages selected from existing newsgroups stored by the super server in the database (*Pan*, p. 33, lines 1-7). Filtering criteria are set through the client applet to specify the newsgroups or part of an improved newsgroup hierarchy across which the filtering criteria is 30 applied (*Pan*, p. 33, lines, 7-9). The criteria, though, is dependent upon the

originator of each message, which is either a newsgroup or newsgroup hierarchy (*Id.*). The filtering criteria can be set to include all newsgroups, but application of the criteria is still limited to messages stored in at least one of the newsgroups, whereas the sender-independent rules recited in Claim 7 apply to any message 5 originating in an information stream, independent of originator. Accordingly, sender-independent message-based rules, per Claim 7, are neither taught nor suggested by Pan.

4. *Pan Is Many-To-One*

Claim 7 recites obtaining a *plurality* of digests from an information stream 10 comprising a *plurality* of candidate messages and further recites, determining for each of the selected candidate messages, *which* of the plurality of digests corresponds to the set of sender-independent message-based rules (emphasis added). In contrast, Pan teaches that custom newsgroups are an aggregation of 15 messages from other newsgroups or a newsgroup hierarchy that meet a set of criteria specified by the user or the administrator of super server application (*Pan*, p. 33, lines 1-7). Messages from one or more newsgroups are selected using the filtering criteria and are included in a single custom newsgroup (*Pan*, p. 33, lines 1-2). Consequently, Pan discloses forming a custom newsgroup in a many-to-one relationship, whereas Claim 7 defines a many-to-many relationship such that a 20 plurality of messages from the information stream can be simultaneously assigned to any of the digests independent of source. Accordingly, determining for each of the selected candidate messages, *which* of the plurality of digests corresponds to the rules, per Claim 7, is neither taught nor suggested by Pan.

5. *Pan Requires Messages From Newsgroups*

Claim 7 recites obtaining a plurality of digests *from an information stream* 25 (emphasis added). In contrast, Pan teaches filtering criteria applied across several existing newsgroups to create a custom newsgroup (*Pan*, p. 33, lines 1-2). The user or the administrator of the super server application can specify the newsgroups across which the specified criteria are applied (*Pan*, p. 33, lines 7-9). 30 The news articles are supplied by the news servers and are stored as static content

(*Pan*, p. 4, lines 9-10). Thus, messages in a custom newsgroup originate first from a user, then are stored in a newsgroup, and finally are filtered against the criteria. Messages must thus go through an intermediary newsgroup, rather than an information stream, per Claim 7 (*Id.*). Accordingly, obtaining messages from an information stream, per Claim 7, is neither taught nor suggested by Pan.

6. *Prima Facie* Case Of Anticipation Is Not Shown

Accordingly, a *prima facie* case of anticipation under 35 U.S.C. § 102(b) has not been shown with respect to independent Claim 7. Claims 8, 10-12, 22, and 24 are dependent on Claim 7 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Moreover, Claim 8 recites delivering the digest to a predetermined destination based on one or more sender-independent message-based rules. Pan neither teaches nor suggests a digest management device that delivers newsgroups based on a set of sender-independent message-based rules. Rather, Pan teaches a Web-like interface to electronic news. The Web-like interface sorts newsgroups into logical categories (*Pan*, p. 5, lines 12-13). A first screen of the user interface includes a series of icons and each icon corresponds to a particular category or grouping of network newsgroups (*Pan*, p. 19, lines 2-8 and Fig. 5). Sorting of newsgroups is different from digesting because digesting allows multiple electronic messages to be collected and sent as a single message (Spec., p. 4, line, 5-6). The user can specify when and how often the digest should be received (Spec., p.6, line 6).

As a *prima facie* case of anticipation has not been established, withdrawal of the rejection of Claims 7-8, 10-12, 22 and 24 under 35 U.S.C. § 102(b) is respectfully requested.

25 E. **Claims 13-14, 16-18, 23, and 25 (Group III)**

1. Group III Claims Should Be Argued Separately

Claims 13-14, 16-18, 23, and 25 define an information storage media that recites information that obtains a plurality of digests, information that monitors the information stream, information that selects one or more of candidate

messages, information that determines which digest corresponds to the set of sender-independent message-based rules, and information that determines and updates the digest. Specific information is not recited in the claims of Group I, II, or IV. Moreover, the devices recited in the elements of the claims of Group I are 5 untied to specific information. Similarly, the steps recited in the claims of Group II are untied to specific information. Finally, the systems recited in the elements of the claims of Group IV are untied to specific information. Accordingly, Claim 13 and Claims 14, 16-18, 23, and 25, dependent thereon, should be reviewed separately.

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2. *Pan* Fails To Disclose Digests

Claim 13 recites information that obtains a plurality of *digests* from an *information stream* comprising a plurality of candidate messages (emphasis added). Claim 13 further recites, information that *monitors* the information stream and *selects* one or more of the plurality of candidate messages *in* the 15 information stream (emphasis added). In contrast, Pan teaches a newsgroup that is an aggregation of posted messages from users that is stored in a database, and which meets a set of criteria specified by the user or the administrator of a super server application (*Pan*, p. 33, lines 6-7). News groups are static content, unlike a plurality of messages selected from an information stream, per Claim 13. The 20 news server is passive and accepts messages newly posted for users without monitoring or selecting, per Claim 13. Finally, custom newsgroups are not distinct newsgroups carried by news servers, but are constructed as an amalgamation of articles of newsgroups supplied and stored by news servers (*Pan*, p. 4, lines 9-10). Accordingly, digests obtained from an information stream, 25 per Claim 13, are neither taught nor suggested by Pan.

3. *Pan* Fails To Disclose Sender-Independent Rules

Claim 13 recites one or more sender-independent message-based rules that specify characteristics of the digest. In contrast, Pan teaches a set of filtering criteria to create custom newsgroups as an aggregation of messages selected from 30 existing newsgroups stored by the super server in the database (*Pan*, p. 33, lines

1-7). Filtering criteria are set through the client applet to specify the newsgroups or part of an improved newsgroup hierarchy across which the filtering criteria is applied (*Pan*, p. 33, lines 7-9). The filtering criteria, though, is dependent upon the originator of each message, which is either a newsgroup or newsgroup hierarchy (*Id.*). The filtering criteria can be set to include all newsgroups, but application of the criteria is still limited to messages stored in at least one of the newsgroups, whereas the sender-independent rules recited in Claim 13 apply to any message originating in an information stream, independent of originator. Accordingly, sender-independent message-based rules, per Claim 13, are neither taught nor suggested by Pan.

4. *Pan* Is Many-To-One

Claim 13 recites information that obtains a *plurality* of digests from an information stream comprising a *plurality* of candidate messages and further recites, information that determines for each of the selected candidate messages, *which* of the plurality of digests corresponds to the set of sender-independent message-based rules (emphasis added). In contrast, Pan teaches that custom newsgroups are an aggregation of messages from other newsgroups or a newsgroup hierarchy that meet a set of criteria specified by the user or the administrator of super server application (*Pan*, p. 33, lines 1-7). Messages from one or more newsgroups are selected using the filtering criteria and are included in a single custom newsgroup (*Pan*, p. 33, lines 1-2). Consequently, Pan discloses forming a custom newsgroup in a many-to-one relationship, whereas Claim 13 defines a many-to-many relationship such that a plurality of messages from the information stream can be simultaneously assigned to any of the digests, independent of source. Accordingly, determining for each of the selected candidate messages, which of the plurality of digests corresponds, per Claim 13, is neither taught nor suggested by Pan.

5. *Pan* Requires Messages From Newsgroups

Claim 13 recites information that obtains a plurality of digests *from* an information stream (emphasis added). In contrast, Pan teaches filtering criteria

applied across several existing newsgroups to create a custom newsgroup (*Pan*, p. 33, lines 1-2). The user or the administrator of the super server application can specify the newsgroups across which the specified criteria are applied (*Pan*, p. 33, lines 7-9). The news articles are supplied by the news servers and are stored as static content (*Pan*, p. 4, lines 9-10). Thus, messages in a custom newsgroup originate first from a user, then are stored in a newsgroup, and finally are filtered against the criteria. Messages must thus go through an intermediary newsgroup, rather than being obtained from an information stream, per Claim 13 (*Id.*). Accordingly, obtaining messages from an information stream, per Claim 13, is neither taught nor suggested by Pan.

6. *Prima Facie* Case Of Anticipation Is Not Shown

Accordingly, a *prima facie* case of anticipation under 35 U.S.C. § 102(b) has not been shown with respect to independent Claim 13. Claims 14, 16-18, 23, and 25 are dependent on Claim 13 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Moreover, Claim 14 recites information that delivers the digest to a predetermined destination based upon satisfaction of at least one or more sender-independent message-based rules. Pan does not disclose information that delivers newsgroups based on a set of sender-independent message-based rules. Rather, Pan teaches a Web-like interface to electronic news. The Web-like interface sorts newsgroups into logical categories (*Pan*, p. 5, lines 12-13). A first screen of the user interface includes a series of icons and each icon corresponds to a particular category or grouping of network newsgroups (*Pan*, p. 19, lines 2-8 and Fig. 5). Sorting of newsgroups is different from digesting because digesting allows multiple electronic messages to be collected and sent as a single message (Spec., p. 4, line, 5-6). The user can specify when and how often the digest should be received (Spec., p.6, line 6).

As a *prima facie* case of anticipation has not been established, withdrawal of the rejection of Claims 13-14, 16-18, 23, and 25 under 35 U.S.C. § 102(b) is respectfully requested.

F. Claims 19 and 20 (Group IV)

1. Group IV Claims Should Be Argued Separately

Claim 19 recites an electronic message management system that includes a digest specification system, a data selection system, and an electronic message management system. Specific systems are not recited in the claims of Groups I, II, and III. Moreover, the devices recited in the elements of the claims of Group I are untied to specific systems. Similarly, the steps recited in the claims of Group II are untied to specific systems. Finally, the information recited in the elements of the claims of Group III is untied to specific systems. Accordingly, Claim 19, and Claim 20, dependent thereon, should be reviewed separately.

2. *Pan* Fails To Disclose Digests

Claim 19 recites a data specification system that allows a user to obtain a plurality of *digests* from an *information stream* comprising a plurality of candidate messages (emphasis added). Claim 19 further recites, a data selection system that *monitors* the information stream and *identifies* one or more of the plurality of messages *in* the information stream (emphasis added). In contrast, Pan teaches a newsgroup that is an aggregation of posted messages from users that is stored in a database, and which meets a set of criteria specified by the user or the administrator of a super server application (*Pan*, p. 33, lines 6-7).

Newsgroups are static content, unlike a plurality of messages selected from an information stream, per Claim 19. The news server is passive and accepts messages newly posted for users without monitoring or selecting, per Claim 19. Finally, custom newsgroups are not distinct newsgroups carried by news servers, but are constructed as an amalgamation of news articles of newsgroups supplied and stored by news servers (*Pan*, p.4, lines 9-10). Accordingly, digests obtained from an information stream, per Claim 19, are neither taught nor suggested by Pan.

3. *Pan* Fails To Disclose Sender-Independent Rules

Claim 19 recites one or more sender-independent message-based rules that specify characteristics of the digest. In contrast, Pan teaches a set of filtering criteria to create custom newsgroups as an aggregation of messages selected from existing newsgroups stored by the super server in the database (*Pan*, p. 33, lines 1-7). Filtering criteria are set through the client applet to specify the newsgroups or part of an improved newsgroup hierarchy across which the filtering criteria is applied (*Pan*, p. 33, lines 7-9). The filtering criteria, though, is dependent upon the originator of each message, which is either a newsgroup or a newsgroup hierarchy (*Id.*). The filtering criteria can be set to include all newsgroups, but application of the criteria is still limited to messages stored in at least one of the newsgroups, whereas the sender-independent rules recited in Claim 19 apply to any message originating in an information stream, independent of originator. Accordingly, sender-independent message-based rules, per Claim 19, is neither taught nor suggested by Pan.

15 4. *Pan* Is Many-To-One

Claim 19 recites obtaining a *plurality* of digests from an information stream comprising a *plurality* of candidate messages and further recites an electronic message management system that determines, for each of the selected candidate messages, *which* of the plurality of digests corresponds to the set of 20 sender-independent message-based rules (emphasis added). In contrast, Pan teaches that custom newsgroups are an aggregation of messages from other newsgroups or a newsgroup hierarchy that meet a set of criteria specified by the user or the administrator of super server application (*Pan*, p. 33, lines 1-7). Messages from one or more newsgroups are selected using the filtering criteria 25 and are included in a single custom newsgroup (*Pan*, p. 33, lines 1-2). Consequently, Pan discloses forming a custom newsgroup in a many-to-one relationship, whereas Claim 19 defines a many-to-many relationship such that a plurality of messages from the information stream can be simultaneously assigned to any of the digests, independent of source. Accordingly, determining for each 30 of the selected candidate messages, *which* of the plurality of digests corresponds to the set of rules, per Claim 19, is neither taught nor suggested by Pan.

5. *Pan* Requires Messages From Newsgroups

Claim 19 recites a digest specification system that obtains a plurality of digests *from an information stream* (emphasis added). In contrast, Pan teaches filtering criteria applied across several existing newsgroups to create a custom newsgroup (*Pan*, p. 33, lines 1-2). The user or the administrator of the super server application can specify the newsgroups or part of the improved newsgroup hierarchy across which the specified criteria is applied (*Pan*, p. 33, lines 7-9). The news articles are supplied by the news servers and are stored as static content (*Pan*, p. 4, lines 9-10). Thus, messages in a custom newsgroup originate first from a user, then are stored in a newsgroup, and finally are filtered against the criteria. Messages must thus go through an intermediary newsgroup, rather than being obtained from an information stream, per Claim 19 (*Id.*). Accordingly, obtaining messages from an information stream, per Claim 19, is neither taught nor suggested by Pan.

15 6. *Prima Facie* Case of Anticipation Is Not Shown

Accordingly, a *prima facie* case of anticipation under 35 U.S.C. § 102(b) has not been shown with respect to independent Claim 19. Claim 20 is dependent on Claim 19 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein.

20 As a *prima facie* case of anticipation has not been established, withdrawal of the rejection of Claims 19 and 20 under 35 U.S.C. § 102(b) is respectfully requested.

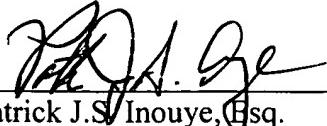
In view of the foregoing arguments, Applicant respectfully submits that the rejections under 35 U.S.C. § 102(b) cannot be sustained and should be withdrawn. Appellant's undersigned attorney can be reached at (206) 381-3900.

Appeal Brief
Docket No. A0834

Dated: September 12, 2006

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Appeal Brief

8. CLAIMS APPENDIX

1 1. (previously presented): An electronic message management system
2 comprising:

3 a digest specification device that allows a user to obtain a plurality of
4 digests from an information stream comprising a plurality of candidate messages
5 by allowing the user to specify a set of one or more sender-independent message-
6 based rules for each digest, wherein each set of one or more sender-independent
7 message-based rules specifies one or more characteristics of the candidate
8 messages;

9 an information selection device that monitors the information stream and
10 selects one or more of the plurality of candidate messages in the information
11 stream that satisfy all of the rules in at least one of the sets of sender-independent
12 message-based rules for at least one of the plurality of digests; and

13 an electronic message management device that determines, for each of the
14 selected candidate messages, which of the plurality of digests corresponds to the
15 set of sender-independent message-based rules satisfied by the particular selected
16 candidate message, that integrates each of the selected candidate messages into
17 their respective corresponding digests, and that determines and updates the digest
18 based on one or more of the sender-independent message-based rules that specify
19 characteristics of the digest.

1 2. (original): The system of claim 1, further comprising a digest
2 management device that delivers the digest to a predetermined destination upon
3 satisfaction of at least one of the one or more sender-independent message-based
4 rules.

1 3. (previously presented): The system of claim 1, further comprising
2 an information sampling device that delivers the selected candidate messages to a
3 predetermined destination based on one or more of the sender-independent
4 message-based rules.

1 4. (original): The system of claim 1, further comprising a rule
2 management device that manages the one or more sender-independent message-
3 based rules.

1 5. (original): The system of claim 1, wherein the one or more sender-
2 independent message-based rules include a Boolean comparison, a statistical-
3 based selection criteria, a fuzzy logic based selection criteria, a keyword based
4 selection criteria, a date, a subject, a recipient or a sender-based selection criteria.

1 6. (original): The system of claim 1, wherein the electronic message
2 is at least one of an e-mail, an electronic message from a mailing list and bulletin
3 board posting.

1 7. (previously presented): A method for managing electronic
2 messages comprising:

3 obtaining a plurality of digests from an information stream comprising a
4 plurality of candidate messages by allowing a user to specify a set of one or more
5 sender-independent message-based rules for each digest, wherein each set of one
6 or more sender-independent message-based rules specifies one or more
7 characteristics of the candidate messages;

8 monitoring the information stream;

9 selecting one or more of the plurality of candidate messages in the
10 information stream that satisfy all of the rules in at least one of the sets of sender-
11 independent message-based rules for at least one of the plurality of digests;

12 determining, for each of the selected candidate messages, which of the
13 plurality of digests corresponds to the set of sender-independent message-based
14 rules satisfied by the particular selected candidate message, and integrating each
15 of the selected candidate messages into their respective corresponding digests;
16 and

17 determining and updating the digest based on one or more of the sender-
18 independent message-based rules that specify characteristics of the digest.

1 8. (original): The method of claim 7, further comprising delivering
2 the digest to a predetermined destination upon satisfaction of at least one of the
3 one or more sender-independent message-based rules.

1 Claim 9 (cancelled).

1 10. (previously presented): The method of claim 7, further comprising
2 delivering selected candidate messages to a predetermined destination based on
3 one or more of the sender-independent message-based rules.

1 11. (original): The method of claim 7, wherein the one or more sender-
2 independent message-based rules include a Boolean comparison, a statistical-
3 based selection criteria, a fuzzy logic based selection criteria, a keyword based
4 selection criteria, a date, a subject, a recipient or a sender-based selection criteria.

1 12. (original): The method of claim 7, wherein the electronic message
2 is at least one of an e-mail, an electronic message from a mailing list and bulletin
3 board posting.

1 13. (previously presented): An information storage media comprising
2 information that manages electronic messages comprising:
3 information that obtains a plurality of digests from an information stream
4 comprising a plurality of candidate messages by allowing a user to specify a set of
5 one or more sender-independent message-based rules for each digest, wherein
6 each set of one or more sender-independent message-based rules specifies one or
7 more characteristics of the candidate messages;

8 information that monitors the information stream;

9 information that selects one or more of the plurality of candidate messages
10 in the information stream that satisfy all of the rules in at least one of the sets of
11 sender-independent message-based rules for at least one of the plurality of
12 digests; and

13 information that determines, for each of the selected candidate messages,
14 which of the plurality of digests corresponds to the set of sender-independent
15 message-based rules satisfied by the particular selected candidate message, and
16 integrates each of the selected candidate messages into their respective
17 corresponding digests; and

18 information that determines and updates the digest based on one or more
19 of the sender-independent message-based rules that specify characteristics of the
20 digest.

1 14. (original): The information storage media of claim 13, further
2 comprising information that deliver the digest to a predetermined destination upon
3 satisfaction of at least one of the one or more sender-independent message-based
4 rules.

1 Claim 15 (cancelled).

1 16. (previously presented): The information storage media of claim 13,
2 further comprising information that delivers the selected candidate messages to a
3 predetermined destination based on one or more of the sender-independent
4 message-based rules.

1 17. (original): The information storage media of claim 13, wherein the
2 one or more sender-independent message-based rules include a Boolean
3 comparison, a statistical-based selection criteria, a fuzzy logic based selection
4 criteria, a keyword based selection criteria, a date, a subject, a recipient or a
5 sender-based selection criteria.

1 18. (original): The information storage media of claim 13, wherein the
2 electronic message is at least one of an e-mail, an electronic message from a
3 mailing list and bulletin board posting.

1 19. (previously presented): An electronic message management system
2 comprising:

3 a digest specification system that allows a user to obtain a plurality of
4 digests from an information stream comprising a plurality of candidate messages
5 by allowing the user to specify a set of one or more sender-independent message-
6 based rules for each digest, wherein each set of one or more sender-independent
7 message-based rules specifies one or more characteristics of the candidate
8 messages;

9 a data selection system that monitors the information stream and identifies
10 one or more of the plurality of candidate messages in the information stream that
11 satisfy all of the rules in at least one of the sets of sender-independent message-
12 based rules for at least one of the plurality of digests; and

13 an electronic message management system functionally associated with
14 the data selection system, the electronic message management system adapted to
15 determine, for each of the identified candidate messages, which of the plurality of
16 digests corresponds to the set of sender-independent message-based rules satisfied
17 by the particular selected candidate message, to integrate each of the identified
18 candidate message into their respective corresponding digests, and to determine
19 and update the digest based on one or more of the sender-independent message-
20 based rules that specify characteristics of the digest.

1 20. (previously presented): The electronic message management
2 system of claim 19, wherein the data selection system samples one or more of the
3 identified candidate messages which meet one or more supplemental selection
4 criteria.

1 21. (previously presented): The electronic message management
2 system of claim 1, wherein the electronic message management device selects one
3 or more of the candidate messages which meet one or more supplemental
4 selection criteria.

1 22. (previously presented): The method for managing electronic
2 messages of claim 7, further comprising selecting one or more of the candidate
3 messages which meet one or more supplemental selection criteria.

1 23. (previously presented): The information storage media of claim 13,
2 further comprising information that selects one or more of the candidate messages
3 which meet one or more supplemental selection criteria.

1 24. (previously presented): The method of claim 7, further comprising
2 managing the one or more sender-independent message-based rules.

1 25. (previously presented): The information storage media of claim 13,
2 further comprising information that manages the one or more sender-independent
3 message-based rules.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.